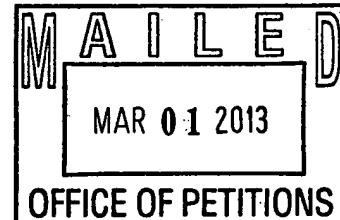




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In re Patent No. 6,475,047
Issue Date: November 5, 2010
Application No. 09/785,941
Filed: February 16, 2001
Title of Invention: **RESCUE DEVICE**

ON PETITION

This is a decision on the petition filed under 37 CFR 1.378(b), January 31, 2013, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(h). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

The patent issued on November 5, 2002. The second maintenance fee due could have been paid during the period from November 5, 2009 to May 4, 2010 or, with a surcharge during the period from May 5, 2010 to November 5, 2010. Accordingly, this patent expired on November 5, 2010 for failure to timely remit the second maintenance fee.

Petitioner Robert Michal, a registered practitioner with Lucas & Mercanti, LLP, asserts that the delay in payment of the maintenance fee was unavoidable in that USP 6,475,047 and the corresponding office file were not transferred to the offices of Lucas & Mercanti, LLP, nor was the patent listed in the docket reports provided by Frishauf, Holtz, Goodman & Chick to Lucas & Mercanti, LLP. As a result, USP 6,475,047 was not entered into the docket system of Lucas & Mercanti, LLP, nor was a change of correspondence address and attorney/agent information submitted to the Patent office. Specifically, petitioner argues that "During my change of offices from Frishauf, Holtz, Goodman & Chick to Lucas & Mercanti, LLP, numerous clients indicated that they wanted me to continue handling their matters, and they therefore authorized Frishauf, Holtz, Goodman & Chick to transfer

responsibility for their matters to me at my new office. As clients provided their authorization to transfer responsibility for matters to me from my former firm to my new firm, files and docket reports were provided by my former firm to me at my new firm. Upon receiving the docket reports from my former firm, the information was provided to the docket department of Lucas & Mercanti, LLP to have all of the matters for which responsibility was being transferred entered into the Lucas & Mercanti docket system. On or about April, 2010, Sam Cynamon, the Patentee of USP 6,475,047, requested that responsibility for his patent matters, including USP 6,475,047, be transferred to me at my new office".

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by:

- (1) The required maintenance fee set forth in § 1.20 (e) through (g);
- (2) The surcharge set forth in § 1.20(i)(1); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

This petition lacks compliance with item (3) above.

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").¹ Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.² In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the

¹Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

²Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.⁴ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.⁵

Assuming that the failure to submit the maintenance fee payment to the USPTO was a clerical error, as noted in MPEP 711.03(c) §(III)(2), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.⁶

An adequate showing as it relates to an error on the part of an employee requires:

- (1) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them;

³ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁴ Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

⁵ Id.

⁶ See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

(2) Petitioner must supply a thorough explanation of how they came to be responsible for matters related to this patent including the ultimate responsibility for payment of maintenance fees and how it is that this matter was not placed in their docketing system; and

(3) Petitioner must supply information regarding the training provided to the personnel responsible for the creation and transfer of the patent records and must describe the work which was used to assure proper execution of assigned tasks.

In this instance, petitioners must show the circumstances surrounding the transfer to and docketing of this patent. Petitioners have not demonstrated what if any measures were in place as a back-up for having this patent placed in the docketing system of the receiving firm and thus for the payment of the maintenance fees.

Unfortunately, no supporting documentation has been provided to support the allegations that the delay in paying the maintenance fees was unavoidable or that either the sending or the receiving firm exercised reasonable care in their duties with respect to this patent.

As prudent and careful practitioners, adequate steps should have been taken in the docketing of this patent and to prevent the delay in the payment of the maintenance fees.

For all the reasons listed above, petitioner has not carried the burden of proof to establish to the satisfaction of the Director that the delay was unavoidable. There is a distinct difference between an unavoidable delay which, had there been reasonable care exercised, could not have been prevented and one that was the result of a mistake. However, in view of the above and since petitioner has not provided enough information for a determination that reasonable care was in fact exercised to ensure that the maintenance fee would be paid timely and that therein the delay was unavoidable, the argument fails.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

Finally, there is no indication that petitioner herein was ever empowered to handle matters related to this patent. If petitioner desires to receive future correspondence regarding this patent, the appropriate power of attorney documentation must be submitted. If the new power of attorney and/or change of address is signed by an assignee, the assignee must comply with the requirements of 37 CFR 3.73(b). This decision will be mailed to petitioner, however, all future correspondence will be mailed solely to the correspondence address of record. If petitioner desires to receive future correspondence regarding any Maintenance Fee Reminder which may be mailed concerning this patent, a Fee Address should be submitted to Maintenance Fee Division.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

/Patricia Faison-Ball/

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions